

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 14449US02)**

In the Matter of: Karaoguz et al.

Serial No. 10/675903

Filed: September 30, 2003

For: Quality of Service Support in a Media Exchange Network

Examiner: Tri H. Phan

Group Art Unit: 2616

Confirmation No. 6132

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application, stated in the final Office Action mailed on April 11, 2006 (hereinafter, the Final Office Action) with a period of reply through July 11, 2006. The Applicants also request review of the arguments stated on page 2 of the Advisory Office Action mailed on June 1, 2006 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-31, all of which have been rejected. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox et al. (US 2003/0158928; hereinafter refer as 'Knox') in view of Liwerant et al. (U.S. 2005/0246752; hereinafter 'Liwerant'). The Applicants respectfully submit that the claims define patentable subject matter. The Applicants also respectfully traverse these rejections as set forth below.

I. Claim Rejections under 35 U.S.C. § 103(a)

With regard to an obviousness rejection, MPEP 2142 states that in order to establish a *prima facie* case of obviousness there must be some suggestion or motivation

to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and *the prior art reference(s) must teach or suggest all the claim limitations*. Further, MPEP 2143.01 states that “the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *AI-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

Knox and Liwerant do not teach all limitations of Claims 1, 11, and 21

With regard to the rejection of independent claims 1, 11, and 21, the Applicants respectfully submit that Knox in view of Liwerant do not disclose “causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user.”

The Final Office Action states on page 3:

In regard to claims 1, 11, and 21, Knox ... fails to explicitly disclose the “display of a plurality of quality of service options corresponding to said at least one media file” for selection by a remote user. However, such implementation is known in the art. (Underline added).

For example, Liwerant discloses about method and system for distributing the sharing video in streaming video over the network, which *causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user* (for example see figure 11, page 10, para [0127-0128]; wherein the screen 1100 provides the user’s control of the operational setting to the configuration and compression of the audio and video settings for the selected uploading file as disclosed in figure 10).

Page 2 of the Advisory Office Action states:

What is missing in the Knox’s reference is “a media file with corresponding of a plurality of service options” for the user to select. On the other hand, Liwerant taught the missing limitation; therefore, Knox in view of Liwerant as clearly pointed out in the office action does indeed teach the claimed invention in a manner as recited and argued; and wherein the details are disclosed in the final rejection sent on April 11, 2006.

The Applicants respectfully point out that paragraphs [0127-0128] in Liwerant do not disclose causing a *display of a plurality of quality of service options **corresponding to said at least one media file*** for selection by a remote user. For example, paragraphs

[0127] and [0128] of Liwerant teach configuring various devices.

The Applicants respectfully draw the attention of the Examiner to the fact that Liwerant is silent with respect to media files.

Liwerant does not teach quality of service options that correspond to a media file, and hence such quality of service options cannot be displayed.

In contrast, the Applicants' claim is directed to, among other things, causing display of a plurality of quality of service options corresponding to a media file.

Accordingly, the Applicants respectfully submit that Knox in view of Liwerant do not disclose "causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user."

Additionally, Liwerant does not teach "causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user" as stated in part in the claims 1, 11, and 21. (Emphasis added).

Rather, Liwerant teaches using a VideoShare Producer 20 software program that is resident on the user's home computer system 10 (second device) where the user is local to the home computer system 10, not a remote user. See page 2, para [0034]; page 3, para [0035], [0039]; page 4, para [0049] ; page 10, para [0127], [0128].

Knox teaches away from Liwerant

M.P.E.P. 2145 (X)(D)(2) states that "[i]t is improper to combine references where the references teach away from their combination." The Applicants respectfully submit that Knox and Liwerant teach away from their combination, and hence the combination of Knox and Liwerant is improper.

For example, Knox teaches a server with a "distributed file system [that] provides services by a user for loading, staging, distributing and delivering a streaming media asset. The file system may be remotely accessible through a web browser, or other client application." See page 2, para [0010], lines 3-7. Liwerant, on the other hand, teaches using a software application program that can be "operated by the user under his control on his computer, in the computer system 10, in order to provide the capability of recording, converting, and optionally, compressing video segments, creating one or more identifiers for a video segment, and transmitting a video segment with one or more identifiers to a host computer 60" Accordingly, Liwerant's method of operating a software application at a user's computer to record, convert, and transmit video segments teaches away from Knox's method of a server providing services for a user "loading, staging, distributing and

delivering a streaming media asset.”

The Applicants respectfully submit that it is improper to combine the teachings of Knox with the teachings of Liwerant in this manner.

Impermissible to “Pick and Choose” Elements

M.P.E.P. 2141 (II)(B) states that “references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.” This is also supported in case law, “It is impermissible within the framework of section 103 to **pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Weslau, 353 F.2d 238, 241 (United States Court of Customs and Patent Appeals, 1965) (emphasis added).

The Applicants respectfully submit that the Final Office Action (page 4) and the Advisory Office Action (page 2) are impermissibly choosing a portion of the Liwerant reference by asserting that Liwerant provides a “media file with a corresponding of a plurality of quality of service options,” which is missing from Knox. As discussed above, Liwerant teaches configuring various devices for processing video segments. The quality of service options in Liwerant are displayed by a software program, VideoShare Producer, operating on the user’s computer and are used to configure various devices “connected to the user’s computer.” Page 10, para [0127]. The Applicants submit that it is impermissible to choose a portion of Liwerant that is intricately entwined with its teachings of using a stand-alone program for the purposes of Knox where a server is used to service clients. That is, the user in Liwerant selects options to configure various devices local to the user’s computer, whereas Knox does not teach configuring various devices on the user’s computer even if the user could select options as taught by Liwerant.

Teaching by Liwerant is unsatisfactory for Knox’s intended purpose

M.P.E.P. 2143.01(V) states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

The Applicants respectfully submit that teaching by Liwerant is unsatisfactory for Knox’s intended purpose. As explained above, Liwerant teaches using a software application at a user’s computer, while Knox teaches a server providing services for clients. Liwerant’s teaching of an application software on a user’s computer operated by the user is unsatisfactory for Knox’s intended purpose of a server providing service to one

or more clients, where the client accesses the server's services via, for example, a web browser. The Applicants respectfully submit that since the teaching of Liwerant is unsatisfactory for Knox's intended purpose, there is no suggestion or motivation to make the proposed modification.

Liwerant changes principle of operation of Knox

M.P.E.P. 2143.01(VI) states "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious".

The Applicants respectfully submit that the modification of Knox by the teachings of Liwerant would change the principle of operation of Knox. As explained above, Liwerant teaches using a software application at a user's computer, while Knox teaches a server providing services for clients. Liwerant's stand-alone method cannot be used by Knox's client-server method without changing Knox's basic principle of operation.

The Applicants respectfully submit that since the teachings of Liwerant will change the principle of operation of Knox, there cannot be a showing of *prima facie* obviousness.

II. Conclusion

The Applicants respectfully submit that the independent claims 1, 11, and 21 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Applicants also respectfully submit that the dependent claims 2-10, 12-20, and 22-31, which depend on the claims 1, 11, and 21, respectively, should also be allowed.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: July 11, 2006

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